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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,867	07/12/2000	Shankar Sahai	1719.0360000	2450
7590 JOHN W. OLIVO, JR. WARD & OLIVO 382 SPRINGFIELD AVENUE SUMMIT, NJ 07901		12/28/2006	EXAMINER LESNIEWSKI, VICTOR D	
			ART UNIT 2152	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/614,867 Examiner Victor Lesniewski	SAHAI ET AL. Art Unit 2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. In the BPAI Decision dated 11/29/2006 the Board has reversed the rejection of claims 1-18 under 35 U.S.C. 112. Therefore, the rejection has been withdrawn.
2. Upon further consideration, new grounds of rejection are made as will be discussed in detail below.
3. Claims 1-18 are now pending.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 9 recites the limitation "said determining means" in lines 12 and 17. There is insufficient antecedent basis for this limitation in the claim. Nowhere in claim 9 is there previous mention of a determining means, making the scope of the claim unclear.
7. Claims 10-16 are rejected due to their dependence on claim 9.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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9. Claims 17 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17 and 18 recite descriptive material that may or may not be an embodiment of a computer system or embodied on a computer readable medium so as to be executable. Here, “a computer program product comprising a computer usable medium” does not constitute eligible subject matter for patentability. See MPEP 2106.IV.B.1.

10. The applicant’s specification defines a computer program product in terms of both statutory and non-statutory embodiments. See the specification, page 16, lines 21-26. The “carrier wave” embodiment is considered non-statutory as a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. A claim that can be read so broadly as to include statutory and non-statutory subject matter must be amended to limit the claim to a practical application.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-6, 9-14, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Lerner (U.S. Patent Number 6,954,799).

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13. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a computer program product are rejected under the same rationale applied to the described claim.

14. Lerner has disclosed:

- <Claims 1, 9, and 17>

A method for redirecting a user from a second Web site to a first Web site, comprising the steps of: (1) providing, by the second Web site, a URL offering a product or service to the user, said URL specifying a program on the second Web site (column 11, lines 3-9); (2) reading, by said program, a cookie located in the user's computer in response to the user activating said URL (column 11, lines 9-14); (3) providing a positive determination when an inquiry by said program, from said cookie as to whether the user already possesses said product or service is true (column 11, lines 32-37); (4) redirecting, by said program, the user to the first Web site when the determination of step (3) is positive determination, wherein the first Web site is specified by said cookie (column 11, lines 32-37); and (5) offering, by the second Web site, to supply said product or service to the user when the determination of step (3) is negative (column 11, lines 14-18); whereby the user who already possesses said product or service will not receive duplicate offers to supply said product or service from multiple Web sites (column 11, lines 32-37).

- <Claims 2, 10, and 18>

The method of claim 1, wherein said providing of step (1) comprises at least one of the following steps of: sending an e-mail including a link to said URL to the user; providing

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a Web page including a link to said URL to the user (column 11, lines 3-9); and providing a computer program including a link to said URL to the user.

- <Claims 3 and 11>

The method of claim 2, wherein said activating of step (2) comprises at least one of the steps of: clicking a link to said URL on a Web page (column 11, lines 7-9); clicking a link to said URL in an e-mail; and executing a computer program that activates a link to said URL.

- <Claims 4 and 12>

The method of claim 1, further comprising a step of: placing, by the first Web site, said cookie the user's computer in response to the user registering with the first Web site for said product or service, said cookie including the URL of the first Web site (column 11, lines 27-31).

- <Claims 5 and 13>

The method of claim 1, wherein said program is a server side program (figure 4, item 402).

- <Claims 6 and 14>

The method of claim 5, wherein said program is at least one of the following: a CGI script; a Java servlet (column 6, lines 15-19); a PHP script; and a Perl script.

Since all the limitations of the invention as set forth in claims 1-6, 9-14, 17, and 18 were disclosed by Lerner, claims 1-6, 9-14, 17, and 18 are rejected.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lerner, as applied above, in view of the applicant's admitted prior art, hereinafter referred to as APA.

17. Lerner disclosed a method for integrating web based applications with each other and with other centralized applications to provide a single sign-on approach for distributed web sites. Lerner's system provides the program functionality that reads the user's cookie on the server side of the system. Thus, concerning claims 7, 8, 15, and 16, Lerner does not explicitly state this program functionality at the client side. However, client side program functionality enabled to read a user's cookie was well known in the art at the time of the applicant's invention. This is evidenced by APA, wherein the applicant states "ActiveX controls and Java applets used to access the file system were well-known to those reasonably skilled in the art at the time of the present invention." See page 34, lines 1-7 of the appeal brief filed 6/3/2005. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Lerner by adding the ability for the program to be a client side program that is downloaded from the second Web site as provided by APA.

18. Thereby, the combination of Lerner and APA discloses:

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- <Claims 7 and 15>

The method of claim 1, wherein said program is a client side program that is downloaded from the second Web site (APA as discussed above).

- <Claims 8 and 16>

The method of claim 7, wherein said program is at least one of the following: a Java applet; a Java script; and an Active X control (APA as discussed above).

Since the combination of Lerner and APA discloses all of the above limitations, claims 7, 8, 15, and 16 are rejected.

*Conclusion*

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

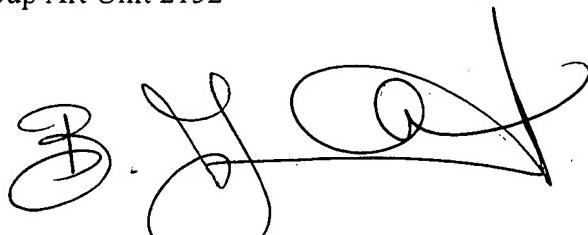
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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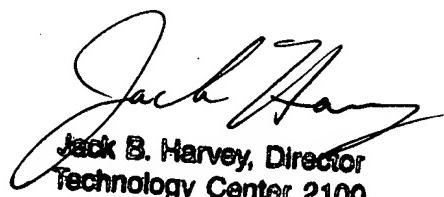
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